



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Handwritten signature

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/680,291

10/06/2000

Alexander P. Moravsky

7000R

9193

7590

11/30/2005

LEOPOLD PRESSER
SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530-0299

EXAMINER

PATEL, ASHOK

ART UNIT

PAPER NUMBER

2879

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 2879

1. After reconsideration of the previous office action (issued by previous Examiner Mr. Glenn Zimmerman), the Examiner believes that claim 67 should not have been allowed in the last office action (at least in terms of prior art rejection under 35 U.S.C. 102 and/or 35 U.S.C. 103). The Examiner also believes that former dependent claims 70 and 73-84 did not appear to be allowable as indicated by the previous Examiner in the last office action (at least in terms of prior art rejection under 35 U.S.C. 102 and/or 35 U.S.C. 103).

In view of the previous Examiner's objection to some of allowable previous dependent claims, current independent claims 70, 75, 76, 78 and 82 should have included limitations of ALL intervening claims.

It is the Examiner's opinion that allowability of claims 67 and 70 and 73-84 should be withdrawn at this time at least due to their broader scope. The Examiner further considers claims 67, 70 and 73-84 restrictable in terms of combination and Sub-Combination group restriction. The Examiner issues the restriction requirement as follows. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 67, drawn to a solid substance, classified in class 428, subclass 367.

Art Unit: 2879

II. Claims 70 and 73-84, drawn to an electron emissive material, classified in class 423, subclass 447.2.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the electron emissive material of Group II does not require the solid substance having more than one half by weight of hollow carbon nanotubes of claim 67, Group I. The subcombination has separate utility such as, a conductive stock material, paste, switch etc.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 2879

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Mr. Mark Cohen on November 23, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok

Art Unit: 2879

Patel whose telephone number is (571) 272-2456. The examiner can normally be reached on M-F, 7AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be reached on (571) 272-2457. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ashok Patel
Primary Examiner
Art Unit 2879